

REED & EBERLE LLP

INTELLECTUAL PROPERTY LAW
800 MENLO AVENUE, SUITE 210
MENLO PARK, CALIFORNIA 94025
(650) 330-0900 TELEPHONE
(650) 330-0980 FACSIMILE
WWW.REEDPATENT.COM

FACSIMILE TRANSMITTAL SHEET

TO:	USPTO Examiner Carlos Azpuru Group Art Unit 1615	FACSIMILE No.: (571) 273-0588 TELEPHONE No.: (571) 272-0588
FROM:	Shelley Eberle Reg. No. 31,411	FACSIMILE No.: (650) 330-0980 TELEPHONE No.: (650) 330-0900
DATE:	June 23, 2004	PAGE 1 OF: 4
SUBJECT:	In Re Application of: Peter TAM et al. Serial No.: 09/996,407 Filing Date: November 21, 2001 Confirmation No.: 3091 Title: AS-NEEDED ADMINISTRATION OF TRICYCLIC AND OTHER NON-SRI ANTIDEPRESSANT DRUGS TO TREAT PREMATURE EJACULATION Atty Dkt No.: 9050-0048.20	CONFIRMATION COPY TO FOLLOW: <input type="checkbox"/> YES <input checked="" type="checkbox"/> NO

Please see the attached Terminal Disclaimer for filing in the subject application.

WARNING: This facsimile message and accompanying documents are intended only for the use of the addressee indicated above. Information that is privileged or otherwise confidential may be contained therein. If you are not the intended recipient, you are hereby notified that any dissemination, copying, review, or use of the above message or the accompanying documents is strictly prohibited. If you have received this message in error, please notify us immediately by telephone or facsimile, and mail the original to us at the above address. Thank you.

PLEASE CALL (650) 330-0900 IF YOU HAVE ANY PROBLEMS RECEIVING THIS TRANSMISSION
OR HAVE RECEIVED THIS TRANSMISSION IN ERROR.

PTO/SB/21 (08-03)

Approved for use through 08/30/2003. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	09/996,407	
	Filing Date	November 21, 2001	
	First Named Inventor	Peter Tam	
	Art Unit	1615	
	Examiner Name	Carlos A. Azpuru	
Mail Stop	Amendment	Attorney Docket Number	9050-0048.20

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> No fee due <input type="checkbox"/> Fee Transmittal <input checked="" type="checkbox"/> Fee(s) due <input checked="" type="checkbox"/> Fee Transmittal <input type="checkbox"/> Check for \$* <input checked="" type="checkbox"/> Charge any underpayment or credit any overpayment to Deposit Account No. 18-0580 <input type="checkbox"/> Return postcard <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement & Form(s) PTO-1449 <input type="checkbox"/> Copy(ies) of cited reference(s) <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts / Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation, Change of Correspondence Address <input checked="" type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s):	<input type="checkbox"/> After Allowance Communication to a Technology Center (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
Remarks: The Commissioner is hereby authorized to charge any additional or underpayment of fee(s) to Deposit Account No. 18-0580.		
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
Firm or Individual Name (print/type)	Shelley P. Eberle, Reg. No. 31,411 Reed & Eberle LLP	Telephone (650) 330-0900
Signature	<i>Shelley Eberle</i>	Date June 23, 2004

CERTIFICATE OF TRANSMISSION/MAILING			
I hereby certify that this correspondence is being facsimile transmitted to Examiner Carlos A. Azpuru in Group Art Unit 1615 of the USPTO at facsimile number (571) 273-0588 on the date shown below.			
Name (print/type)	Joe Clark		
Signature	<i>Joe Clark</i>	Date	June 23, 2004

PTO/SB/96 (08-03)

Approved for use 7/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING
REJECTION OVER A PRIOR PATENT**Docket Number (Optional)
9050-0048.20

In re Application of: Peter TAM et al.

Application No.: 09/996,407

Filed: November 21, 2001

For: AS-NEEDED ADMINISTRATION OF TRICYCLIC AND OTHER NON-SRI ANTIDEPRESSANT DRUGS TO
TREAT PREMATURE EJACULATION

The owner, VIVUS Inc., of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 6,495,154. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney or agent of record.

06/24/2004 YCHADWIC 00000001 180580 09996407
Sale Ref: 00000001 DAW: 180580 09996407
01 FC:2814 55.00 DA

Shelley Eberle
Signature

June 23, 2004
Date

Shelley P. Eberle, Reg. No. 31,411

Typed or printed name

650-330-0900

Telephone Number

- ☐ Please charge the terminal disclaimer fee under 37 CFR 1.20(d) to Deposit Account No. 18-0580.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).
Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

This collection of information is required by 37 CFR 1.321. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.